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EXAMINER	
NGUYEN, CUONG H	

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/963,855	SINGH ET AL.	
	Examiner	Art Unit	
	CUONG H. NGUYEN	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *28-37,45 and 46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *28-37,45 and 46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/27/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the election submitted on 7/06/04 (claims 28-37 were elected), which papers have been placed of record in the file.

2. Claims 26-37 are pending in this application. Claims 45-46 were added on 3/05/2004

Drawings

3. This application has been filed with formal drawings (Figs. 1-24) which are acceptable by the examiner for examining purposes.

Response:

4. The examiner is unpersuasive with the amendment submitted on 3/05/2004 because independent claim 28 contains intend of use languages which are not considered as limitations for this system claim - that should comprises (physical) components, modules, devices, apparatus .etc. (i.e., "...of the matching search listings, the search result list being transmitted to the searcher as ordered in response to receipt of the search query from the searcher, the search engine transferring economic value from the respective advertiser associated with a referred search listing when the referred search listing is referred to the searcher" ; and "..., the agent being configured to receive an automatic notification condition definition from an advertiser, the automatic notification condition definition defining at least one search listing of the advertiser to be monitored and a condition to monitor of the search listing to be monitored, the agent being further configured to provide condition update information to the advertiser in response to a change in the condition to monitor." .

In new claim 45: "a system...to **provide one of** an instant message to a set of instant message accounts prescribed by the advertiser,
a fax message to a fax number prescribed by the advertiser,
a page message to a page number prescribed by the advertiser, and a voice telephone message to a telephone number prescribed by the advertiser
as the condition update information to the advertiser." (in this claim, an instant message is represented for this providing action).

In new claim 46: "a system ... **to provide one of** an active link embedded in the notification, an inactive link in the notification, a response e-mail template, and a response telephone number as the condition update information to the advertiser." (in this claim, a telephone number is represented for this providing action.

Therefore, the cited references read-on the claimed languages.

For the examiner 's interpretation of claims' weight of these claims' limitations, please refer to Ex parte **Masham**, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987), *In re* ***Kuehl***, 177 USPQ 250 (CCPA 1973), ***ex parte Pfeiffer***, 1962 C.D. 408 (1961), and In re **Thorpe**, 227 USPQ 964 (Fed. Cir. 1985).

A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. Ex parte **Masham**, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims **28-29, 31, 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ryan** et al.(US Pat. 6,421,675).

A. Re. To claim **28**: Ryan et al.. teach a database search system comprising:

a database of search listings, each search listing being associated with a respective advertiser/"content provider" (see **Ryan** et al., the abstract, and 34:44-65), each search listing including a search term and at least one of a variable cost per click (CPC) (see **Ryan** et al., 34:66 to 35:9).

Ryan et al. teach that a search engine configured to identify search listings matching a search query received from a searcher, the matching search listings being ordered in a search result list according to a display rank (see **Ryan** et al., 1:59 to 2:4), and the bid amount; these results are in the form of a list, ranked according to criteria specific to the search engine of the matching

search listings; and an agent (see **Ryan** et al., Figs.2, 23) responsive to a condition definition from an advertiser to provide condition update information to the advertiser.

Although Ryan et al. do not disclose exactly the claimed language, it would be obvious to one of ordinary skill in the art to recognize that Ryan et al.'s invention is sufficient to teach claimed ideas because Ryan et al. disclose similar structural components that make up a search engine as claimed.

B. As to claim **29**, Ryan et al. teach a database search system wherein an agent is configured to receive as the condition definition an indication of search listings and indication of CPC range (see **Ryan** et al. 33:15-18), and wherein the agent is configured **to provide** as the condition update information **a notification** (see **Ryan** et al. 34:60-65).

It would have been obvious to one of ordinary skill in the art to use a search system to send a message/notification that CPC for the indicated search listings has reached the indicated CPC range because this act simply acknowledge a user about a predetermined threshold stored in said system. Artisans would recognize that this is very convenient in their search.

C. As to claim **31**, Ryan et al. teach a database search system comprising an advertiser **account management device** (see **Ryan** et al.: Fig. 24, and 34:66 to 35:7).

Ryan et al. do not teach about an agent receiving minimum account balance.

However, the examiner submits that it is old and well-known in a search engine that using an account administrator to manage/report a balance of an advertiser.

It would be obvious to one of ordinary skill in the art to utilize a processor in the system of Ryan et al. to compare a balance of an advertiser to a predetermined number and report the findings to the agent/user. Artisans would recognize that this is necessary in reporting current related information.

D. As to claim **33**, Ryan et al. teach a database search system comprising an advertiser account management device (see **Ryan** et al. 34:66 to 35:3) configured to **count clicks** for specified search listings (see Ryan et al. 33:15-18), and wherein the agent is configured to receive click-counted search listings and an associated click limit (see **Ryan** et al. 33:15-20).

6. Claim **30** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ryan** et al.(US Pat. 6,421,675), in view of **Goto.com** article published on 5/19/1998.

. Ryan et al. teach a database search system wherein the agent is configured to **receive** as the condition definition an indication of search listings and **indication of desired rank** (see cited Goto.com article that teaches about bidding for more prominent placement/rank), and wherein the **agent** is configured to **provide** as the condition **update** information **a notification** (see **Ryan** et al. 34:60-65).

The examiner submits that this claimed information is obvious to one of ordinary skill in the art. Ryan et al. teach about an agent 's search engine that receiving a desired rank from a user's input, and providing notification to update information through interactive communications upon receiving a feedback from that search system.

It would have been obvious to one of ordinary skill in the art to combine the teachings of Ryan et al. and Goto.com teachings in using a search system to send a message/notification about a desired rank because this act simply acknowledge a user about a current status of a search term stored in said system. Artisans would recognize that this reflects a selection of a user quickly in real-time.

7. Claim **32** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ryan** et al.(US Pat. 6,421,675), in view of **Langheinrich** et al. (US Pat. 6,654,725).

Ryan et al. teach a database search system comprising

an advertiser account management device (see **Ryan** et al., 34:66 to 35:3) configured to count impressions/hit (see **Ryan** et al., 16:49-60, and 26:39-40).

Ryan et al. do not expressly disclose about impression rates.

However, Langheinrich et al. explain the use of that impression rates in advertisements (see **Langheinrich** et al., 5:36-50).

(The examiner notes that the specification gives an example for "impression" object such as: "… an impression is defined as follows. Whenever a user types in a search term, a set of matching search results are presented. The presentation of a listing to a user is counted as an impression. If a listing is on a following page, and the user does not search beyond the current page, then this does not count as an impression. Other definitions may be used as well. If the rank of a listing changes, then the number of impressions for the listing can be reset to zero.", "The economic value is given when one or more network locations, such as advertiser web sites, are referred to a searcher. The referral may be by presenting the network locations on a screen used for data entry and receipt by the searcher, alone or with other search results. This is referred to as **an impression.**", "**a banner**" (Like traditional advertising, banner advertising on the Internet is typically priced on an

impression basis with advertisers paying for exposures to potential consumers. Banners may be displayed at every page access, or, on search engines, may be targeted to search terms).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Ryan et al. and Langheinrich et al., in advertisement because they provide a database search system which customizes electronic advertisements to be delivered to users. Artisans would recognize that these cited prior art specified search listings and wherein the agent is configured to receive as the condition definition an indication of impression-counted search listings and an associated impression limit, because a number is always used for artisans to indicate a threshold/limitation for a definiteness, this limit is old and well-known.

7. Claim **34** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ryan** et al.(US Pat. 6,421,675), in view of **Golding** et al. (US Pat. 6,640,218).

Ryan et al. teach a database search system comprising an advertiser account management device (see **Ryan** et al. 34:66 to 35:3) configured to **measure a click-through rate** for specified search listings and wherein the agent is configured to receive as the condition definition an indication of click through rate search listings. and an associated click through rate limit.

Ryan et al. teach a database search system comprising an advertiser account management device configured to measure a click through rate for specified search listings and wherein the agent is configured to receive as the condition definition an indication of click through rate search listings and an associated click through rate limit.

The examiner notes that the specification defines about click-through rate as followings: "impression-based advertising inefficiently exploits the Internet's direct marketing potential, as the click-through rate, the rate of consumer visits a banner generates to the destination site.

Ryan et al. do not disclose about an associated click-through rate limit.

However, Golding et al. disclose that limit by using "relative Quality Adjusted Selection Rates" (see **Golding** et al., 12:13-24).

It would have been obvious to one of ordinary skill in the art to combine the teachings of Ryan et al. and Golding et al. in using a search system to determine rate limits of search clicks. Artisans would recognize that this reflects a more accurate rate of counting in selecting a right term for searching.

7. Claim **35** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ryan** et al.(US Pat. 6,421,675), in view of **Golding** et al. (US Pat. 6,640,218),
and further in view of the Official Notice.

Ryan et al. teach a database search system wherein the associated click through rate comprises an aggregate click through rate for a combination of the click through rate search listings.

Ryan et al. and Golding et al. do not disclose that "associated click through rate comprises an aggregate click through rate for a combination of the click through rate search listings".

However, the Official Notice is taken here that a combination of the click through rate search listings are counted for in click through rate.

It would have been obvious to one of ordinary skill in the art to implement Ryan et al. and Golding et al. with the above Official Notice taken because accounting for a combination of click through rate search listing would increase accuracy in calculating rates in searching.

8. Claim **36** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ryan** et al.(US Pat. 6,421,675), in view of the Official Notice.

Ryan et al. teach a database search system comprising an advertiser account management device (see **Ryan** et al., 34:66 to 35:3) configured to measure an average cost per click through for specified search listings and wherein the agent is configured to receive average cost per click through search listings and an associated limit.

Ryan et al. do not disclose about measuring an average cost per click-through and an associated limit.

However, the Official Notice is taken here that it is old and well-known for an agent to receive specific data by Internet (for the claimed system, it is not necessary that "a receiving data must be a click-through limit", cited art of Ryan et al. receive specific information; that might include "receiving average cost per click through search listings and an associated limit"; (please note that for a system claim, a search agent can received any specific information wherein the specific info. are non-functional material that do not contribute to patentability of that system).

It would have been obvious to one of ordinary skill in the art to implement Ryan et al. with the above Official Notice taken because artisans would recognize that a database search system can receive a non-functional descriptive material such as an average cost per click-through search listing and associated limit, and still maintaining structural relationships of components in a database search system as claimed.

9. Claim **37** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ryan** et al.(US Pat. 6,421,675).

Ryan et al. teach a database search system wherein the agent is configured to receive as the condition definition

an indication of the minimum CPC required to attain a given display rank for a search term.

Ryan et al. do not disclose that "an agent is configured to receive as the condition definition an indication of the minimum CPC required to attain a given display rank for a search term".

However, the examiner submits that "receiving minimum required CPC" would be specified by a user of the database search system because this is a non-functional descriptive material; in another word, the cited system of Ryan et al. would receive any specific data including "receiving minimum required CPC (see **Ryan** et al. 33:15-18).

It would have been obvious to one of ordinary skill in the art to implement Ryan et al. to "receive minimum CPC required to attain a given display rank for a search term" because the claimed language is directed to a **system** comprising structural components as in Ryan et al.'s invention, which can receive specific data.

10. Claims **45-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ryan** et al.(US Pat. 6,421,675), in view of **Linsey** et al.(US Pat. 6,791,852).

A. Re. To new claim **45**: Ryan et al. teach a database search system comprising a database of search listings associated with advertisers and a processing system (see **Ryan** et al., the abstract, and 2:25-35), (please note that

"which **sends a notification** to an advertiser when a change condition of a search listing of the advertiser has occurred" is an inherent function of Ryan 's system and is a capability of Ryan et al.'s system to serve a purpose of interactive communication between Ryan's system and a user/advertiser (see **Ryan** et al., 34:63-65).

Ryan et al. do not disclose about using an instant message.

However, for the same subject matter, Linsey et al. use that for communications (see Linsey et al., 2:34-39).

It would have been obvious to one of ordinary skill in the art to implement Linsey et al.'s idea in Ryan et al. to use this available means in communications for the advantage of fast distribution a message on the Internet.

B. Re. To new claim **46**: Ryan et al. teach a database search system comprising:

- a database of search listings, (please note a fact that each search listing being associated with a party/(a web listing) is inherently taught in Ryan et al. invention (see **Ryan** et al., the abstract); a search engine (see **Ryan** et al., the abstract, and 2:25-53); and

Ryan et al. inherently teach about providing an indication to an advertiser by interactive communication (see **Ryan** et al., 34:63-65).

Ryan et al. do not disclose about updating a telephone number in a database.

However, for the same subject matter, Linsey et al. use that updating of a database for conveniences (see Linsey et al., 29:1-12).

It would have been obvious to one of ordinary skill in the art to implement Linsey et al.'s idea in Ryan et al. to use this updating for necessary information such as a telephone number in database for the advantage of current/corrected contact and distribution.

Conclusion

11. Claims **26-37, 45-46** are not patentable. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for

reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-330 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Thomas G. Black can be reached on 703-305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Cuonghnguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3661